Serial No.: 09/463,675
Art Unit: 1751

REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 15 - 22 remain pending in this application.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

The Examiner has maintained his election/restiction requirement on the grounds that the special technical feature identified by Applicant as being present in each of the groups identified by the Examiner fails to make a contribution over the prior art due to the citation of X and Y references in the PCT Search Report.

In response to Applicant's request that the Examiner cite the relevant legal precedent in support of this position, the Examiner contends that PCT Rules 13.1 and 13.2 say, ***in essence***, that an obvious or anticipated invention lacks unity of invention. Applicant once again traverses the restriction requirement on the grounds that the Examiner has failed to satisfy the burden of proof necessary for establishing a lack of unity of invention, and requests reconsideration thereof. In the meantime, claims 23-30 have been cancelled, without prejudice.

Claims 15-20 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinelt et al. (US 5,880,086). This rejection is again respectfully traversed for the following reasons.

It is extremely well settled that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. See, *Manual of Patent Examining Procedure*, Rev. 3, July 1997, § 2142, page 2100-108. Applicant respectfully submits that the Weinelt reference fails to render the claimed invention prima facie obvious on the grounds that it fails to teach or suggest each and every claimed element thereof. More particularly, the reference fails to teach or suggest the use of **BOTH** a nonionic surfactant and a polyol in the claimed ratio by weight.

The Weinelt reference clearly teaches that both a nonionic surfactant and a polyol are merely optional components. As a result, one of ordinary skill in the art might arguably employ neither the nonionic surfactant nor the polyol, let alone both in the claimed ratio by weight. Clearly, there is no teaching or suggestion which might motivate the routineer to wish to employ both the nonionic surfactant and the polyol in the claimed ratio by weight. This point is further supported by the Examiner's realization in Paper No. 11, page 4, paragraph 7, that examples 4 and 5 are described as being "low-viscosity" since it is clearly seen that neither of these examples disclose the use of both a nonionic surfactant and a polyol **in the claimed ratio by weight.** In view of this teaching, one of ordinary skill in the art, wishing to formulate such a composition having a low viscosity would **NOT** be motivated to modify the teachings of the Weinelt reference in a manner which would read on the claimed invention since a low-viscosity formulation is already described in examples 4 and 5, **without the need for modification.**

The Examiner states in Paper No. 13, page 3, that while the Weinelt reference admittedly does not teach Applicant's claimed weight ratio, by following the teachings of the reference, Applicant ***could*** make compositions which do meet this ratio. In response thereto, Applicant would like to note that it has been held that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. See, Ex parte

Gerlach, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). It is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, In re Soli, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. See, In re Wagner et al, 152 USPQ 552 (CCPA 1967).

Accordingly, for all of the above-disclosed reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 21 and 22 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinelt et al. (US 5,880,086) in view of Severns et al. (US 5,531,910). This rejection is again respectfully traversed for the following reasons.

The shortcomings associated with Weinelt reference have once again been outlined above. It is Applicant's position that since low-viscosity formulations such as those **noted by the Examiner** (examples 4 and 5) can be obtained without modifying the Weinelt composition in such a way that it would read on the claimed invention, i.e., employing both a nonionic surfactant and a polyol in the claimed ratio by weight, there exists no basis in fact within the reference from which the requisite motivation to employ the claimed combination of the two optional components, might stem.

As for the Severns reference, it is relied upon merely for its teaching regarding the use of glycerol. However, based on the above-described shortcomings of the Weinelt reference, Applicant cannot understand why one of ordinary skill in the art would wish to employ two unnecessary components which will increase the costs associated with formulating the composition, and then unduly experiment with various weight ratio combinations in an effort to make a low viscosity composition in accordance with the claimed invention when a low viscosity composition can be formulated, based on examples

Serial No.: 09/463,675
Art Unit: 1751

4 and 5 of the reference, without going through such unnecessary gyrations.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

Steven J. Trzaska
(Reg. No. 36,296)
Attorney For Applicant(s)
(610) 278-4929

Cognis Corporation
2500 Renaissance Blvd., St. 200
Gulph Mills, PA 19406

SJT/mc G:\DATA\TRZASKA\H3033FIN.DOC